

## **REMARKS**

Applicants would like to thank the Examiner for the careful consideration given to the present application. The present application currently has claims 1-15 and 25-26 pending. Applicants have added new claims 27 and 28. The application has been carefully reviewed in light of the Office Action. Applicants respectfully submit that the claims are patentable over the cited references for at least the reasons set forth below. Reconsideration of this application is hereby requested.

### **Claim Rejections – 35 U.S.C. 103**

The Examiner has rejected claims 1-4 and 10-14 under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification in view of Teter et al. (U.S. Patent No. 6,112,665). Applicants traverse this rejection for the following reasons. To establish a *prima facie* case of obviousness, one criterion that must be met is that there must be some suggestion or motivation to combine reference teachings. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner states that Applicants admitted prior art discloses the idea of covering a color card with a single color but does not disclose the idea of placing perforations on the card to form a detachable paint chip. Further, the Examiner states that Teter et al. teaches the idea of placing perforations within a colored section in order to allow the perforated area to be removed. The Examiner has combined Teter et al. in combination with Applicants prior art teaching, and has asserted that claims 1-4 and 10-14 are obvious in light of the combined references.

Applicants respectfully submit that there is absolutely no suggestion or motivation to combine the two teachings that the Examiner has used to make the instant rejection. As such, independent claims 1 and 10, and accordingly all claims depending therefrom, are not obvious.

With respect to the Examiner's combination of Applicants prior art teaching and Teter et al., there is no suggestion in either reference to combine the references to arrive at placing perforations on a single-color paint card in order to form a detachable paint chip on such single-color card. The mere fact that the references *can* be combined does not render the resultant

combination obvious unless the prior art also suggests the desirability of the combination. (See *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Absent any suggestion or motivation to combine, it cannot be obvious to combine the references.

The Teter et al. reference is specifically directed to “blanks” that are provided for producing color swatches in a printer or photocopier. Neither Applicants disclosure nor Teter provide any motivation to combine the blanks that are provided therein with a single-color color card. The Teter patent is an invention for a blank. The claims in the Teter reference relate to a blank that can be adapted for a printer. The Abstract, Background (see specifically Col. 1, lines 42-45), Summary, and Description have numerous and repetitious references to the fact that the invention is directed to a blank. There would be no motivation, and there is no suggestion, to combine a reference that discloses an invention for blanks with an invention for a single-color color card.

As previously mentioned, the teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art. The Examiner states that it would have been obvious to one in the art to modify Applicant’s prior art by adding perforations to form a detachable chip. However, Applicants believe that the Examiner has not shown any suggestion for the combination. The Examiner has not shown that there is anything in Teter to suggest the desirability, and therefore the obviousness, of making the combination of perforated sections in anything other than a blank that is to be put through a printer or copier. Other than the Examiner’s mere statement that the combination would allow for better color matching – i.e., the Examiner’s statement that the references can be combined – there is no evidence to show that there is motivation to combine a reference teaching and claiming blanks with an invention for a paint color card – i.e., there is no showing of a suggestion of desirability of the combination of references.

Furthermore, as Applicants previously presented in the Response to Office Action dated March 15, 2005, Teter et al. is the type of color card that Applicant has referenced as being undesirable – a conventional color card with a multitude of colors. The distinctions previously cited by Application between single-color and multiple-color color cards, as well as Applicants teaching of the undesirability of using a multiple-color color card, in fact teach away from any combination of a single-color color card with a multiple-color color card reference. The

“teaching away” by Applicants and the failure of the references to show desirability of their combination render the subject invention non-obvious.

For the foregoing reasons, Applicants believe that independent claims 1 and 10 are not obvious, and therefore all claims depending from claims 1 and 10 are not obvious.

With respect to claim 2, Applicants also traverse this rejection. Applicants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There is no basis for an obviousness rejection of claim 2 in light of the failure of the references to provide any suggestion or motivation to be combined.

With respect to claims 3 and 13, Applicants traverse this rejection. The Examiner has stated that Applicants prior art in view of Teter does not disclose the chip section. The Examiner states that Teter does not disclose the shape of the chip section and that since Applicants have failed to provide any advantage to making the chip section square, the round shape taught by Teter would work equally well. Additionally, the Examiner states that it would be within one skilled in the art to modify the Teter disclosure of a round-shaped chip section to a square-shaped chip section. Applicants disagree with the Examiner’s statements.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). As such, it must be shown that there is suggestion to combine the references, regardless of Examiner’s statement that Applicant’s have not shown any advantage to making the chip sections square. There must be some objective reason to combine the teachings of the references. *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter 1993). As presented above, there is no suggestion for the Examiner’s combination of teachings. Teter’s invention, as discussed above, is a blank that can be put through a printer or copier. The Examiner has not provided an objective reason for why a reference disclosing and claiming blanks should be combined with a paint color card. Furthermore, there must be support or explanation for the Examiner’s assertion that such modification is within one skilled in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The Examiner has not provided any support or

explanation for his conclusion that one skilled in the art would have combined the Applicants teachings with Teter.

The failure to provide any teachings for a generally square chip sections, in addition to the fact that the independent claims are not obvious, support a finding that claims 3 and 13 are also not obvious.

With respect to claims 4 and 14, Applicants also traverse this rejection. Applicants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There is no basis for an obviousness rejection of claims 4 and 14 in light of the failure of the references to provide any suggestion or motivation to be combined, as discussed above.

Applicants also traverse the rejection of claim 11. With respect to claim 11, Applicants believe that neither the teachings of the prior art as stated in Applicants specification nor the Teter et al. reference disclose the element of a tear line that has ends that are separated by a space in which the paint color card is not perforated. Again, in order to meeting a finding of *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. Applicants maintain that the Teter et al. reference does not disclose the element of a tear line that has ends separated by a space in which the color card is not perforated. The Examiner has stated, perforations inherently have a space between each hole/perforation. However, Applicants claim is directed to there being a space between the ends of the tear line, the space being an area where the paint color card is not perforated. The space between the ends of the tear line is not the space defined inherently by the perforations, but rather an area where there are no perforations at all. On the contrary, the circular perforation depicted in Teter is a continuous perforated line without a non-perforated area that is different from the non-perforated areas within the (or which are part of) perforated line. Moreover, the Examiner has failed to show the remaining elements of claim 11 as taught by Teter. There is no teaching in Teter that the openings described in Teter can operate as a chip section that can be folded over along a fold

line to form a window. Furthermore, the fold line must extend between the ends of the tear line – this is also absent from Teter. Throughout the Teter et al. reference, the perforated sections are always depicted as circular holes, i.e., perforations in a circular arrangement. There is no section of the perforated area that has a space of non-perforation that could operate as a fold line where the chip section can be folded over to create a window. The Teter perforated areas do not appear to have the functionality or capability of a fold over chip section. Accordingly, claim 11 is not obvious.

Additionally, because independent claim 10 is nonobvious, then any claim depending from the independent claim is also nonobvious.

The Examiner has rejected claims 5-7 and 15 under 35 U.S.C. 103(a) as being unpatentable over Applicants admitted prior art in view of Teter et al. and further in view of Day et al. Applicants traverse this rejection. Applicants prior art discussion as provided in the specification of the subject application and the Teter et al. reference cannot properly be combined because of the lack of suggestion or motivation to combine them. Applicants have provided arguments in favor of this position with respect to independent claims 1 and 10, above. As such, dependent claims 5-7 and 15 also cannot be obvious.

The Examiner has rejected claims 8 and 25 under 35 U.S.C. 103(a) as being unpatentable over Applicants prior art discussion in the specification in view of Teter et al. and further in view of Edwards (U.S. Patent No. 4,992,050) or Goldsholl (U.S. Patent No. 3,224,113). Applicants traverse this rejection for the following reasons. As Applicants have stated above, Applicants prior art discussion and Teter et al. are not properly combinable because there is no suggestion or motivation to combine the references. As such, independent claim 1 is not obvious and claim 8, depending from claim 1, is also not obvious. Applicants also believe that claim 10 is not obvious for reasons set forth above, and as such, claim 25 is also not obvious.

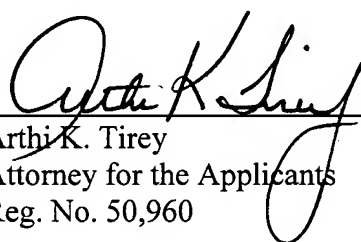
The Examiner has rejected claims 9 and 26 under 35 U.S.C. 103(a) as being unpatentable over Applicants prior art discussion in the specification in view of Teter et al. as applied to claim 1 and 10 and further in view of Goldsholl. Applicants traverse this rejection for the following reasons. As Applicants have stated above, Applicants prior art discussion and Teter et al. are not

properly combinable because there is no suggestion or motivation to combine the references. As such, independent claims 1 and 10 are not obvious and claims 9 and 26, depending from claims 1 and 10 respectively, are also not obvious.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If the Examiner has any questions with respect to the foregoing, he is invited to contact the undersigned. Applicants would like to again thank the Examiner for his review of the subject application.

Respectfully submitted,

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